

Serial No. 08/401,229

Claims 23 and 28 have been amended following the Examiner's suggestion to refer to "said other end". Claims 32, 33, and 37 have been amended following the Examiner's additional suggestion to provide antecedent support for the "light signal" by indicating that the light signal is "the returning light signal".

Claims 31 and 36 have been rewritten to clarify the elements and their arrangement for conversion of the light signal to an electrical signal as supported by the present specification in Fig. 5 and the corresponding text at page 14, line 25 through page 15, line 6 in response to the "new matter" objection.

No new matter has been added.

The amendments should be entered because they will clearly reduce the issues on appeal and place the application in condition for allowance. The amendments should be entered because, for the most part, they were suggested by the Examiner in the Office Action. As for the electrical slipring claims, these have been amended based on Fig. 5 and its accompanying text to overcome the "new matter" objection.

In view of the foregoing amendments and the following remarks, favorable reconsideration of this application is courteously solicited.

I. 35 U.S.C. § 112, SECOND PARAGRAPH

Claims 23-30, 32, 33, and 37 have been rejected under the second paragraph of 35 U.S.C. § 112 for indefiniteness (Office Action at page 2). Reconsideration of the rejection is respectfully requested.

Claims 23 and 28 have been amended following the Examiner's suggestion to refer to "said other end". Claims 32, 33, and 37 have been amended following the Examiner's additional suggestion to provide antecedent support for the "light signal" by indicating that the light signal is "the returning light signal".

In view of the amendments, withdrawal of the rejection under the second paragraph of 35 U.S.C. § 112 is requested.

II. 35 U.S.C. § 112, FIRST PARAGRAPH

The specification has been objected to and claims 31-38 have been rejected under the first paragraph of 35 U.S.C. § 112 for alleged lack of enablement (Office Action at page 3). Reconsideration of the objection/rejection is respectfully requested.

On page 3, the Action states as follows:

There is no indication whatsoever in the specification, in either general or specific terms, of the necessary elements (or their arrangement) for such conversion to operatively occur. The person of ordinary skill in the art would be at a loss as to how to effect the use of an electrical slipring in combination with the bifurcated fiber-optic cable as set forth in claims 31-38.

To the contrary, Fig. 5 and the corresponding text of the present specification clearly describe the necessary elements and their arrangement within the CMP context for converting a light signal to an electrical signal and decoupling the electrical signal from rotation through the use of an electrical slipring. Claims 31 and 36 have been rewritten to clarify the elements and their arrangement for conversion of the light signal to an electrical signal as explicitly supported by the present specification in Fig. 5 and the corresponding text at page 14, line 25 through page 15, line 6.

In view of the amendments to claims 31 and 36, the objection/rejection under the first paragraph of 35 U.S.C. § 112 should be withdrawn.

III. 35 U.S.C. § 103

Claims 19, 20, and 23-30 have been rejected under 35 U.S.C. § 103 as obvious over Cleveland (Office Action at pages 4-7). Reconsideration of the rejection is respectfully requested.

In accordance with the indication on page 7 of the Office Action that claim 17 is patentable over Cleveland because it recites "means for analyzing a light signal to determine thickness change and stopping thickness change when the thickness

Serial No. 08/401,229

reaches a predetermined endpoint", claims 19, 23, and 28 have been amended to recite the same feature.

In view of the amendments, withdrawal of the rejection under 35 U.S.C. § 103 is requested.

In view of the above amendments and remarks, favorable reconsideration and allowance of this application are requested. In the event that any issues remain, the Examiner is invited to telephone the office of the undersigned if it would expedite prosecution.

Respectfully submitted,

June 17, 1996
Date

Stephen B. Maebius
Stephen B. Maebius
Registration No. 35,264

FOLEY & LARDNER
3000 K Street, N.W., Suite 500
P.O. Box 25696
Washington, D.C. 20007-8696
phone: (202) 672-5569
fax: (202) 672-5399